

**REMARKS**

As a result of the amendments made herein, Claims 48-53 have been canceled. Claims 42, 54, 60, 64, 70 and 77 have been amended. Claims 48-53 have been canceled. Applicants respectfully submit that no new matter has been added. Accordingly, Claims 42-47 and 54-83 are at issue.

The present invention is drawn to a system and apparatus for displaying advertising indicia on a wireless device. Referring to exemplary Claim 42, a page signal is received at a wireless device such as a pager, and in response thereto, an advertisement is immediately displayed at the pager. After waiting a predetermined period of time, paging information is then displayed at the pager. Later, the user can select to view the paging information. In response to that selection, the system detects a user preference, wherein the user preference indicates whether the user prefers to view the paging information without viewing the advertisement. In other words, the user has a choice between (a) viewing the paging information without viewing the advertisement, and (b) viewing the advertisement, and then viewing the paging information. The user's choice between those two alternatives is stored as a user preference. The present invention detects that preference and, based upon that preference, pursues the user-preferred alternative.

Another inventive aspect of the present invention relates to how the advertisements are programmed and stored at the wireless device. Referring to exemplary Claim 70, the wireless device has a set of advertisements and a set of periods of time. Each of the periods of time has a duration, which is the length of time for which the advertisement is displayed at the device. Furthermore, each of the periods of time is programmable so as to have a duration that is different from every other period of time. Each advertisement is associated with a subset of the periods of time. For example, and as described in the present application on page 10:

"if YAHOO and COKE placed advertising requests, and YAHOO paid more than COKE, then the wireless device 2 could be programmed to have a cycle with four slots, and YAHOO would take up three of the four slots, with COKE taking up the fourth slot. Thus, YAHOO would appear three times in a row, for the first three pages, and COKE would come up on the fourth page. This cycle can be repeated. Other numbers of slots in one cycle could also be used. Other

programming methods come to mind by one of ordinary skill in the art, so long as the proper percentage of appearances is achieved."

As will be demonstrated herein, none of the prior art cited by the Examiner, either alone or in combination, discloses or suggests those aspects of the present invention.

### **Remarks Concerning Rejections Under 35 U.S.C. § 102**

On page 3 of the August 9, 2005 Office Action, the Examiner rejected Claims 48 and 70 under § 102(e) as being anticipated by U.S. Patent No. 6,674,357 to Bermel ("Bermel"). In light of the amendments made herein, Applicants respectfully traverse that rejection. Bermel is directed to an apparatus for displaying information messages communicated to a plurality of wireless display devices. The messages are each placed in a slot in the memory of the display device (col. 5, ll. 3-7). The messages are then each displayed for a duration, wherein the duration depends on the general *type* of the message (col. 5, ll. 48-55). For example, news messages are displayed for thirty seconds, and advertisements are displayed for fifteen seconds (*Id.*). Bermel does not disclose that each individual message (within a particular type) can have a unique duration; Bermel discloses only that the duration of each message is based on its general type. The Bermel system does not permit, for example, displaying a COKE *advertisement* for a first duration and displaying a YAHOO *advertisement* for a second duration, because both would fall into the same general type according to Bermel. That feature is explicitly described in the application as originally filed, and in Claims 48 and 70 as amended herein. Bermel contains no such disclosure of that feature.

Bermel also fails to disclose a second feature of the present invention: the step of associating an advertisement with a subset of the set of periods of time. In Bermel, each message is associated with a single slot. However, the "slots" in Bermel are not periods of time; they are merely storage positions in a memory; the "slots" of Bermel are therefore not analogous to the "periods of time" of the present invention. Moreover, the present invention provides that an advertisement is associated with a *subset* of those periods of time, meaning that each advertisement can be associated with more than one period of time. Bermel does not disclose that limitation.

Claims 48 and 70 have both been amended herein to clarify that each of the periods of time is programmable to have a duration that is different from the other periods of time, *and* that each advertisement is associated with a subset of the periods of time. Bermel does not disclose or suggest either of those elements. Therefore, Applicants respectfully submit that Claims 48 and 70 are patentable over Bermel, and request that the § 102 rejection based on that reference be withdrawn.

In previous communications regarding the present application, the Examiner had also rejected certain claims under U.S. Patent No. 6,031,467 to Hymel et al ("Hymel"). The Examiner did not reiterate that objection in the August 9, 2005 Office Action, and Applicants therefore regard that rejection as having been withdrawn.

#### **Remarks Concerning Rejections Under 35 U.S.C. § 103**

##### Hymel in view of U.S. Patent No. 6,819,225 to Wicks et al. ("Wicks")

On page 4 of the August 9, 2005 Office Action, the Examiner rejected Claims 42-43, 54-55, 60 and 64-65 under § 103(a) as being unpatentable over Hymel in view of Wicks. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Hymel is directed to a radio that receives personal messages and corresponding advertisements. To view personal messages on the radio, the user is first required to view the advertisement. If the user views the personal message *without* viewing the advertisement, the user is penalized by having the radio disabled from receiving other personal messages (col. 4, ll. 41-54). As the Examiner acknowledged on page 4 of the August 9, 2005 Office Action, Hymel fails to disclose detecting a user preference to view paging information without viewing an advertisement.

Wicks fails to cure the deficiencies of Hymel. Wicks is directed to a pager that receives pricing information. The pricing information is compared to a user profile that describes the interests of the pager user. If the pricing information matches the interests in the user profile, then the pricing information is transmitted to the pager. On page 5 of the August 9, 2005 Office Action, the Examiner equated that functionality with the user preference of the present invention. Those two features, however, are not analogous. In the present invention, the user preference

describes whether the user wishes to view paging information *without* viewing advertising information. The "user profile" described in Wicks does not contain any preference to that effect; it relates only generally to the interests of the user, such as "an interest in sports" or "an interest in movies", *not* to whether the user prefers to view paging information without viewing advertising information. In other words, the user profile of Wicks determines which messages the user will receive, whereas the user preference of the present invention determines how those messages will be viewed. The two are not analogous.

Claims 42, 54, 60 and 64 have all been herein amended to clarify that the user preference of the present invention indicates whether the user prefers to view paging information without viewing an advertisement. Neither Hymel nor Wicks discloses or suggests that element. Applicants therefore respectfully submit that Claims 42, 54, 60 and 64 are patentable over Hymel and Wicks, and request that the rejection based on those references be withdrawn.

Dependent Claim 43 includes all of the features of Claim 42 and is therefore patentable over Hymel and Wicks for the same reasons. Likewise, dependent Claims 55 and 65 depend on Claims 54 and 64, respectively. Applicants therefore request that the § 103 rejection of the Claims 42-43, 54-55, 60 and 64-65 be withdrawn.

Hymel and Wicks in view of U.S. Patent No. 6,477,365 to Fukuda ("Fukuda")

On page 8 of the August 9, 2005 Office Action, the Examiner rejected Claims 45 and 67 as being unpatentable over Hymel and Wicks in further view of Fukuda. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Fukuda is directed a portable telephone communication system, wherein voice recordings are attached to communications between a mobile telephone and a radio tower. The Examiner has relied upon Fukuda for disclosing the feature of including a company name in an advertisement. Like Hymel and Wicks, however, Fukuda does not disclose a user preference that indicates whether a user prefers to view paging information without viewing an advertisement. Claims 42 and 60 both include that element, and therefore dependent Claims 45 and 67, respectively, include that element as well. Applicants thus respectfully submit that Claims 45 and 67 are patentable over that combination, and request that the rejection based thereon be withdrawn.

Hymel and Wicks in view of U.S. Patent No. 6,434,383 to Bruno et al. ("Bruno")

On page 8 of the August 9, 2005 Office Action, the Examiner rejected Claims 46-47 and 68-69 as being unpatentable over Hymel and Wicks in further view of Bruno. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Bruno is directed to a paging system that determines whether a user is logged into a computer network. If so, a page is directed to that user's personal computer. The Examiner has relied upon Bruno for disclosing the feature of paging information that includes a person's name and phone number. Like Hymel and Wicks, however, Bruno does not disclose a user preference that indicates whether a user prefers to view paging information without viewing an advertisement. Claims 42 and 60 both include that element, and therefore dependent Claims 46-47 and 68-69, respectively, include that element as well. Applicants thus respectfully submit that those claims are patentable over that combination, and request that the rejection based thereon be withdrawn.

Hymel in view of Bermel

On page 9 of the August 9, 2005 Office Action, the Examiner rejected Claims 49, 50, 71-73 and 77-80 as being unpatentable over Hymel in view of Bermel. Claim 50 has been canceled herein, rendering moot that rejection. As to Claims 49, 71-73 and 77-80, in light of the amendments made herein, Applicants respectfully traverse that rejection.

As described previously, Bermel is directed to a system wherein informational messages are associated with memory "slots" in a pager. The Examiner has relied upon Bermel for disclosing the step of programming a pager at a service provider or retailer. However, as described previously, neither Hymel nor Bermel disclose or suggest a user preference indicating whether the user prefers to view paging information without viewing an advertisement. Claims 42 and 70 both include that element, and therefore dependent Claims 49 and 71-73, respectively, include that element as well. The combination of Hymel and Bermel thus does not render Claims 49 and 71-73 unpatentable. Applicants respectfully submit that those claims are patentable over Hymel and Bermel, and request that the rejection based thereon be withdrawn.

Hymel and Bermel also fail to disclose another element found in Claims 77-80, which is the step of associating an advertisement with a subset of periods of time within the wireless device. In the present invention, each advertisement is associated with a subset of time periods, and it is that association which determines the frequency with which the advertisement will be displayed. Neither Hymel nor Bermel discloses that element. Applicants therefore respectfully submit that Claims 77-80 are patentable over the combination of Hymel and Bermel, and request that the rejection based on those references be withdrawn.

Bermel in view of Fukuda

On page 11 of the August 9, 2005 Office Action, the Examiner rejected Claims 51, 74 and 81 as being unpatentable over Bermel in view of Fukuda. Claim 51 has been canceled herein, rendering moot that rejection. As to Claims 74 and 81, in light of the amendments made herein, Applicants respectfully traverse that rejection.

As described previously, neither Bermel nor Fukuda disclose or suggest a user preference indicating whether a user prefers to view paging information without viewing an advertisement. Claim 70 includes that limitation, and therefore dependent Claim 74 includes that limitation as well. Applicants respectfully submit that Claim 74 is thus patentable over the combination of Bermel and Fukuda, and request that the rejection based thereon be withdrawn.

Bermel and Fukuda also fail to disclose the step of associating an advertisement with a subset of periods of time, as described previously. Claim 77 includes that limitation, and therefore dependent Claim 81 includes that limitation as well. Applicants respectfully submit that Claim 81 is thus patentable over the combination of Bermel and Fukuda, and request that the rejection based thereon be withdrawn.

Bermel in view of Bruno

On page 12 of the August 9, 2005 Office Action, the Examiner rejected Claims 52-53 and 75-76 as being unpatentable over Bermel in view of Bruno. Claims 52-53 have been herein canceled, rendering moot the rejection as to those claims. As to Claims 75-76, in light of the amendments made herein, Applicants respectfully traverse that rejection.

In the present invention, each of the periods of time in the wireless device has a duration, which is programmable so as to be different from the duration of the other periods of time. Claim 70 has been amended herein to clarify that feature of the present invention. Claims 75-76 are dependent upon Claim 70, and therefore include that element as well. Neither Bermel nor Bruno discloses or suggests that element. Applicants therefore respectfully submit that Claims 75-76 are patentable over the combination of Bermel and Bruno, and request that the rejection based on those references be withdrawn.

Hymel and Wicks in view of U.S. Patent No. 6,157,814 to Hymel et al. ("Hymel II")

On page 12 of the August 9, 2005 Office Action, the Examiner rejected Claims 44, 56-57 and 66 as being unpatentable over Hymel and Wicks in view of Hymel II. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Neither Hymel, Wicks nor Hymel II disclose a user preference indicating whether the user prefers to view paging information without viewing an advertisement. Claims 42, 54 and 60 all include that element. Dependent Claims 44, 56-57 and 66, respectively, therefore also include that element. Applicants thus respectfully submit that Claims 44, 56-57 and 66 are patentable over the combination of Hymel, Wicks and Hymel II, and request that the rejection based on those references be withdrawn.

Hymel and Wicks in view of U.S. Patent No. 6,008,819 to Robson et al. ("Robson")

On page 15 of the August 9, 2005 Office Action, the Examiner rejected Claim 61 as being unpatentable over Hymel and Wicks in view of Robson. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Robson is directed to an information retrieval device that receives a portion of a document. Based upon input from the user, additional information is transmitted to the device, such as another portion of the document, or a nested hyperlink. Robson does not disclose, however, a user preference indicating whether the user prefers to view paging information without first viewing an advertisement. As noted previously, Hymel and Wicks also fail to disclose that element, which is found in Claim 60. Claim 61 is dependent upon Claim 60, and therefore also includes that element. Applicants therefore respectfully submit that Claim 61 is

patentable over the combination of Hymel, Wicks and Robson, and request that the rejection based on those references be withdrawn.

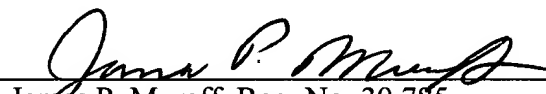
### CONCLUSION

In light of the amendments and remarks made herein, Applicants respectfully submit that Claims 42-47 and 54-83 are in condition for allowance. Applicants respectfully request that the Examiner withdraw the rejections and allow all the claims to issue. If it may be of assistance to contact the undersigned Attorney regarding the present invention, the Examiner is invited to do so.

Respectfully submitted,

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By:

  
James P. Muraff, Reg. No. 39,785  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive, 53<sup>rd</sup> Floor  
Chicago, Illinois 60606-6630  
312.554.3300

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Gillian Gardner/236186